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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,777	03/28/2006	William F. Rossiter	0579-1121	5523

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YOUNG & THOMPSON
209 Madison Street
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EXAMINER

ANDLER, MICHAEL S

ART UNIT	PAPER NUMBER
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2876

NOTIFICATION DATE	DELIVERY MODE
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08/19/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/573,777	Applicant(s) ROSSITER, WILLIAM F.	
	Examiner Michael Andler	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges and has entered the arguments filed on 8 June 2010. Claims **1, 3-8, 10, 12-15, 18 and 20-28** are currently pending.

Priority

2. The examiner thanks the applicant for providing the certified translation of foreign reference FR 0311364. The examiner acknowledges that the certified documents are sufficient to perfect the priority claim to the foreign reference in accordance with 37 CFR 1.55 (See MPEP, Section 201.15).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims **1, 7-8, 10, 12-15, 24-28**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) in view of Smith et al. (US 7,065,195) and Pentz et al. (US 6,471,127).

Regarding claims **1, 12-15 and 27**, Nishikawa et al. discloses a card, comprising:
a card body (Fig 47B: item 40),
comprised of a microcircuit card precut in the card body (See Fig 47B: item 41),
a token precut in the card body so as to be adjacent to the microcircuit card and
extending up to a corner of the card body (Fig 47B: item 43), and

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the token carrying visual information (See Fig 47B).

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card (See Fig 47B).

Nishikawa et al. does not specifically teach a remainder portion of the card body removably joined to both the microcircuit card and the token, and including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card, wherein the token is a contactless type; wherein the visual information comprises characters in relief.

Smith et al. discloses a remainder portion of the card body removably joined to both the microcircuit card and the token (See Fig 1A: item 120 where a remainder portion, in general, can be considered any portion of the card body that remains after removal of the microcircuit card) and wherein the token is connected to the remainder portion of the card body by mechanically weakened areas consisting of grooves (Col 3, lines 4-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Smith et al. in order to provide a means of allowing a user to conveniently carry a telephone calling card number on a key ring (See Smith et al., Fig 1D).

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card that are removable from one another (See Fig 47B).

Smith et al. suggests an invention for providing a combined keytag portion and a miniature telephone calling card portion that are removable from one another (See Fig 1A).

Nishikawa et al. and Smith et al. do not specifically teach including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card, wherein the token is a contactless type, wherein the visual information comprises characters in relief.

Pentz et al. discloses including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card (See Fig 2A, item 22), wherein the token is a contactless (RFID) type (Col 5, line 14), wherein the visual information comprises characters in relief (Fig 1A, item 11: raised lettering).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Pentz et al. in order to provide a means of allowing a user to conveniently carry a telephone calling card on a key ring (See Pentz et al., Abstract).

Regarding claim **7**, Nishikawa et al. discloses wherein the card body conforms to ID-1 format (Col 27, lines 4-6 and Col 21, lines 25-27).

Regarding claim **8**, Nishikawa et al. discloses wherein the microcircuit card conforms to ID-000 format (Col 1, line 21).

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Regarding claim **10**, Nishikawa et al. discloses wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

Regarding claim **24**, Nishikawa et al. discloses wherein the visual information includes personalizing information (See Fig 33A, item 17A: individual identification information).

Regarding claim **25**, Nishikawa et al. discloses wherein the visual information includes an address or a phone number (Fig 47B).

Regarding claim **26**, Nishikawa et al. discloses wherein the visual information is provided in ink (See Fig 1A, item 62: print information).

Regarding claim **28**, Nishikawa et al. discloses wherein the card body further comprises an L-shaped residual portion detachably connected to the microcircuit card and to the token (See Fig 47: item 45).

b) Claims **3-6, 18 and 20-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) as modified by Smith et al. (US 7,065,195) and Pentz et al. (US 6,471,127) as applied to claim **1** above, and further in view of Lubking (D498,788).

Regarding claims **3-4 and 21-23**, Nishikawa et al. as modified by Smith et al. and Pentz et al. as applied to claim **1** above, discloses all the limitations of claim **1**.

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card that are removable from one another (See Fig 47B).

Pentz et al. suggests an invention for a miniature credit card (See Figs 4A-D).

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Nishikawa et al. and Smith et al. and Pentz et al. do not specifically teach wherein the token extends to only one corner of the card body and wherein the corner has a furthest distance from the microcircuit card.

Lubking suggests and invention for combining a credit card and a miniature credit card that are removable from one another (See Fig 4).

Lubking et al. discloses wherein the token extends to only one corner of the card body and wherein the corner has a furthest distance from the microcircuit card (See Fig 4 where, in general, the phrase “extends to” or “extending up to” can be considered synonymous with "extends towards" or “extending up towards”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Lubking in order to provide a customer with a removable miniature credit card in a full credit card package that may also function as a telephone calling card (See Lubking, Figs 4 and 7).

Regarding claim **5**, Nishikawa et al. discloses wherein the token has sides at least approximately parallel to those of the card body (Fig 47B).

Regarding claim **6**, Nishikawa et al. discloses wherein the token has sides at least approximately aligned with the sides of the microcircuit card (Fig 47B).

Regarding claims **18 and 20**, Nishikawa et al. discloses wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

Response to Arguments

4. Regarding claims **1 and 21-23**, applicant has perfected the priority claim to foreign reference FR 0311364, filed 29 September 2003, in accordance with 37 CFR 1.55 (See MPEP, Section 201.15) and has argued that the previously cited intervening prior art reference of Anders et al. (US 7,384,000) is no longer available as prior art.

Applicant's arguments with respect to the prior art reference of Anders et al. have been fully considered and are persuasive. Therefore, the rejection to claims **1 and 21-23** has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly discovered prior art reference of Lubking (US D498,788).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385 and whose e-mail address is michael.andler@uspto.gov. The examiner can normally be reached on Monday-Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Andler/
Examiner, Art Unit 2876

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876